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In re Application
Burnworth, et al.
Application No. 10/665,930
Filed: September 19, 2003
Dkt. No.: TAYL08-00002

: OFFICE OF PETITIONS
:
: PATENT TERM ADJUSTMENT
:
:

This is in response to the "REQUEST FOR REONCSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(b)," filed February 2, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is 390 days, not 344 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and, on the basis that the applicant delay is also improperly calculated.

This matter is being properly treated under 37 CFR 1.705(b) as an application for patent term adjustment.

37 CFR 1.702(b)

Insofar as the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

37 CFR 1.704(c)(3)

Applicants herein contest the reduction of 346 days under 37 CFR 1.704(c)(3) in connection with the petition to revive and response to non-final Office action filed July 27, 2007. Applicants assert that the period of reduction in this regard is 362 days, from November 15, 2006 to November 12, 2007.

A review of the record reveals that the correct adjustment in connection with the petition to revive and response to non-final office action filed July 27, 2007 is 469 days pursuant to 37 CFR 1.704(c)(3). The reduction commenced August 16, 2006, the date of abandonment of the application, and ended November 27, 2007, the date that is four months after the date that a grantable petition was filed. See, 37 CFR 1.704(c)(3)(ii).

In view thereof, the request for correction of the reduction of is GRANTED TO THE EXTENT INDICATED HEREIN.

CONCLUSION

Accordingly, as of the time of allowance, the application is entitled to an overall patent term adjustment of 221 days (adjustment of 690 days less reduction of 469 days).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Receipt is hereby acknowledged of the required patent term adjustment application fee of \$200.00. See, 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Adjusted PAIR Calculation

PTA Calculations for Application: 10/665930

Application Filing Date:	09/19/2003	PTO Delay (PTO):	690
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	346
Post-Issue Petitions:	0	Total PTA (days):	221
PTO Delay Adjustment:	-123		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
112	07/02/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		469	
111	07/02/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	346		
68	11/02/2009	MAIL NOTICE OF ALLOWANCE			
67	10/27/2009	ISSUE REVISION COMPLETED			
66	10/27/2009	DOCUMENT VERIFICATION			
65	10/26/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
64	10/26/2009	NOTICE OF ALLOWABILITY			
60	09/03/2009	DATE FORWARDED TO EXAMINER			
59	07/08/2009	RESPONSE AFTER NON-FINAL ACTION			
58	06/08/2009	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
57	06/05/2009	MISCELLANEOUS ACTION WITH SSP			
56	04/03/2009	DATE FORWARDED TO EXAMINER			
55	03/30/2009	RESPONSE AFTER NON-FINAL ACTION			
54	06/23/2008	REFERENCE CAPTURE ON IDS			
53	06/23/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
52	01/30/2009	MAIL NON-FINAL REJECTION			
51	01/29/2009	NON-FINAL REJECTION			
50	06/23/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
49	11/29/2008	DATE FORWARDED TO EXAMINER			
48	10/28/2008	RESPONSE AFTER NON-FINAL ACTION			
47	10/20/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
46	10/16/2008	MISCELLANEOUS ACTION WITH SSP			
45	08/12/2008	DATE FORWARDED TO EXAMINER			

44	06/26/2008	RCE- AF PROCESSED			
43	08/12/2008	DATE FORWARDED TO EXAMINER			
42	07/21/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
41	08/12/2008	DISPOSAL FOR A RCE / CPA / R129			
40	07/21/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
39	07/10/2008	MAIL ADVISORY ACTION (PTOL - 303)			
38	07/08/2008	ADVISORY ACTION (PTOL-303)			
37	07/02/2008	DATE FORWARDED TO EXAMINER			
36	06/26/2008	AMENDMENT AFTER FINAL REJECTION			
35	06/23/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
34	04/23/2008	MAIL FINAL REJECTION (PTOL - 326)	148		31
33	04/22/2008	FINAL REJECTION			
32	02/28/2008	DATE FORWARDED TO EXAMINER			
31	07/27/2007	RESPONSE AFTER NON-FINAL ACTION		346	19
30	11/27/2007	MAIL NOTICE OF RESCINDED ABANDONMENT			
29	11/27/2007	NOTICE OF RESCINDED ABANDONMENT IN TCS			
26	02/12/2008	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
25	02/11/2008	CORRESPONDENCE ADDRESS CHANGE			
24	11/27/2007	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
23	11/27/2007	PETITION TO REVIVE APPLICATION - GRANTED			
22	07/12/2007	PETITION ENTERED			
21	04/04/2007	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
20	04/01/2007	ABAND. FOR FAILURE TO RESPOND TO O. A.			
19	05/15/2006	MAIL NON-FINAL REJECTION	542		-1
18	05/12/2006	NON-FINAL REJECTION			
17	03/31/2006	CASE DOCKETED TO EXAMINER IN GAU			
16	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
15	02/22/2006	CASE DOCKETED TO EXAMINER IN GAU			
14	06/25/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
13	06/24/2004	CASE DOCKETED TO EXAMINER IN GAU			
12	03/18/2004	APPLICATION RETURN FROM OIPE			

11	03/18/2004	APPLICATION RETURN TO OIPE			
10	03/18/2004	APPLICATION DISPATCHED FROM OIPE			
9	03/18/2004	APPLICATION IS NOW COMPLETE			
8	03/01/2004	ADDITIONAL APPLICATION FILING FEES			
7	03/01/2004	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	09/19/2003	CLAIM PRELIMINARY AMENDMENT			
5	12/12/2003	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
4	12/02/2003	CASE CLASSIFIED BY OIPE			
3	12/02/2003	CLEARED BY OIPE CSR			
2	10/29/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/19/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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